

REMARKS

Claims 1-4 and 6-23 are currently pending in the application. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

35 U.S.C. §103(a) Rejections

Over Beach with Meyer

Claims 1-4 and 6-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0107738 to BEACH et al. ("BEACH") in view of U.S. Patent No. 6,915,271 to MEYER et al. ("MEYER"). This rejection is respectfully traversed.

Applicants submit that the Examiner has failed to set forth a *prima facie* case of unpatentability under 35 U.S.C. § 103 because no proper combination of the above-noted documents discloses or suggests the combination of features recited in at least independent claims 1, 2, 7, 11, 12 and 17.

In particular, independent claims 1, 2, 7, 11, 12 and 17 recite, *inter alia*, checking a database of promotions for presence of a promotion that includes the qualifying value.

Furthermore, independent claim 1 recites, *inter alia*,

when a promotion that includes the qualifying value is present in the database, associating the qualifying value of the promotion with a module of selectively executable compiled web server code residing on a server's body of compiled code, selecting the module of selectively executable compiled web server code and executing the module of selectively executable compiled web server code that provides the promotion, wherein the associating is made explicitly by pointers that are included in terms of the promotions.

Furthermore, independent claim 2 recites, *inter alia*,

when a promotion that includes the qualifying value is present in the database, determining a reward value of the promotion that includes the qualifying value based on associating a module of selectively executable compiled web server code residing on a server's body of compiled code made explicitly by pointers that are included in terms of the promotion; and executing the module of selectively executable compiled code associated with the reward.

Additionally, independent claim 7 recites, *inter alia*,

when a promotion that includes the qualifying value is present in the database, determining whether the promotion that includes the qualifying value is active; and when the promotion that includes the qualifying value is active, determining a reward value of the promotion that includes the qualifying value and executing a module of selectively executable compiled code associated with the reward value.

Also, independent claim 11 recites, *inter alia*,

when a promotion that includes the qualifying value is present in the database, executing a module of selectively executable compiled web server code that provides the promotion.

Moreover, independent claim 12 recites, *inter alia*,

when a promotion that includes the qualifying value is present in the database, determining a reward value of the promotion that includes the qualifying value; and executing a module of selectively executable compiled code associated with the reward value.

Finally, independent claim 17 recites, *inter alia*,

when a promotion that includes the qualifying value is present in the database, determining whether the promotion that includes the qualifying value is active; and when the promotion that includes the qualifying value is active, determining a reward value of the promotion that includes the qualifying value and executing a module of selectively executable compiled code associated with the reward value.

Applicants submit that neither BEACH nor MEYER discloses or suggests, at least these features.

The Examiner apparently believes that the qualifying purchase (paragraph [0024]) of BEACH constitutes the recited qualifying value and that the coupons (paragraph [0035]) of BEACH constitute the recited promotion, and concludes that BEACH therefore discloses checking a database of promotions for presence of a promotion that includes the qualifying value. Applicants respectfully disagree.

Under the Examiner's characterization, BEACH discloses checking a database of coupons (i.e., the recited promotions) for presence of a coupon (i.e., the recited promotion) that includes the qualifying purchase (i.e., the recited qualifying value). However, this is not what BEACH in fact discloses. Paragraph [0035] of BEACH merely discloses the following:

[0035] In practice, as depicted in FIG. 2, a manufacturer (or other entity) will arrange with a coupon registration service center 212 for the issuance of coupons. The service center 112 will store the appropriate information defining the coupons (such as value of the coupon, time limits or quantity limits on validity, types of purchases required to redeem and the like), e.g., on a disk drive or similar storage device. Various retail locations 126 will have agents 138 installed 214 having access to the store's POS computer 134 and/or database 136. The consumer 114 communicates or registers 216, e.g., using an Internet connection 118 or other communication means, with the service center 112. Although a number of embodiments are possible, in at least one embodiment, the user will, e.g., on a first visit to the web site, provide an identifying number (such as a frequent shopper number, name and address, credit card number and the like) and will identify a bank account, credit card account or other account to which coupon credits will be deposited. In some embodiments, this information may be provided to, or obtained by, the service center 112 in a substantially automatically or transparent fashion (such as by storing or retrieving Internet "cookies"). In at least some embodiments, the user can select among various coupons which the user would like to take advantage of. Preferably the service center 112 provides a user interface and/or software to assist the consumer in selecting desired coupons and/or to promote coupons or products of various manufacturers, retailers and the like. For example, in some embodiments the user may enter or download some or all items from a shopping list (including an electronic shopping list) and the service center 112 will search a database to locate coupons which exactly or roughly correspond to items which the consumer intends to purchase. In some embodiments, the service center may suggest items or coupons to the user, e.g., for based on information stored or accessible

to the service center 112 regarding the consumer or the consumer's family or other group. Systems for suggesting shopping items and/or coupons can be used similar to those described in U.S. patent application Ser. No. 60,153,965 (Attorney File 3730-918), incorporated herein by reference. Preferably, the service center 112 can be configured to provide the consumer 114 with a (preferably printable) display showing the items (or classes of items) which the consumer must purchase in order to qualify for the coupons and/or showing the name, address or other location of one or more retail locations where such items can be purchased (and which are configured with an agent 138 for automatic fulfillment or redemption, as described herein). If desired, the service center 112 can be configured to communicate the list of coupon items, preferably associated with the consumer's frequent shopper number or other identifier, to a facility at one or more retail locations 126 so that a consumer can retrieve the list of items to purchase (for coupon redemption) at the retail location, e.g., as generally described in U.S. patent application Ser. No. 60,154,006, supra. The consumer visits the retail location 126 and makes one or more qualifying purchases 218. At the time of checkout 134, or at a later time, the agent 138 uses information in the POS computer 134 or database 136 to verify or identify compliance with coupon criteria 222, i.e., to verify or identify purchases which fulfill requirements for redemption of one or more coupons (e.g., as described more thoroughly below.) Thereafter, the coupon amount for such redeemed coupons are electronically deposited 224 in a consumer's account, such as a bank account 158 or the like (emphasis added).

As the Examiner will note, the above-noted language discloses checking a database to locate coupons which exactly or roughly correspond to items which the consumer intends to purchase; not checking a database of coupons (i.e., the recited promotions) for presence of a coupon (i.e., the recited promotion) that includes the qualifying purchase (i.e., the recited qualifying value). Nor has the Examiner explained how such disclosure can be interpreted to disclose checking a database of promotions for presence of a promotion that includes the qualifying value.

The Examiner also points to paragraph [0025] as disclosing associating the qualifying value of the promotion with a module of selectively executable compiled web server code. Applicants respectfully disagree. Paragraph [0025] of BEACH merely discloses the following:

[0025] When a visitor or consumer 114 visits 132 a retail location 126 and purchases items, as the items are entered at a check-out or sales location 134 (such as by scanning product codes or the like), information regarding the consumer's purchases is provided to a backroom or point-of-sale (POS) computer 134. Although a point-of-sale computer 134 is typically located in the retail location 126, embodiments of the present invention can also be implemented when information from check-out stations 134 is provided to remotely-located computers. Typically, a POS computer 134 will maintain a log of consumer's purchases, e.g., on a disk drive or other storage device 136. The POS computer 134 is preferably provided with information regarding the identity (or an identifier number) of the consumer 114 such as when the consumer uses a frequent shopper card, a credit card or other identifying card or token, or otherwise provides identifying information during the retail checkout procedure. Preferably, the information identifying the computer 114 and provided to the POS computer 134 either is the same information which the consumer 114 used as an identification when communicating with the service center 112, or is information which can be used to access or retrieve the identifying information which the consumer used in communicating with the service center 112. For example, it is possible for a consumer to provide a credit card number as an identifier when communicating with the service center 112, but to use a frequent shopper card or number during the checkout procedure at the retail location 134. However, if the retail location has (or can access) a database which correlates the consumer's frequent shopper number with the consumer's credit card number, the POS computer still has sufficient information to correlate the consumer 114 who purchases item at the checkout 134 with an identification of a consumer who has communicated with the service center 112 (emphasis added).

Accepting the Examiner's characterization of the claim feature, the above noted language should disclose associating the qualifying purchase (i.e., the recited qualifying value) of the coupon (i.e., the recited promotion) with a module of selectively executable compiled web server code. However, it is clear from a fair review of paragraph [0025] that this is not what is disclosed. Nor has the Examiner explained how such disclosure can be interpreted to disclose associating the qualifying value of the promotion with a module of selectively executable compiled web server code.

The Examiner acknowledges that BEACH fails to disclose or suggest executing the module of selectively executable compiled web server code that provides the promotion and that the associating is made explicitly by pointers that are included in

terms of the promotions. However, the Examiner asserts that this feature is taught by MEYER. Applicants respectfully disagree.

The Examiner cites col. 34, lines 48-65 of MEYER as disclosing "an associated product/service, pointers to related incentives." However, Applicants question the relevancy of such an assertion. The claims do not recite this feature and instead recite that the associating is made explicitly by pointers that are included in terms of the promotions. Furthermore, it is clear that the noted language of MEYER does not support the Examiner's assertion. Indeed, col. 34, lines 48-65 of MEYER merely states the following:

Once the incentive is displayed (whether a default incentive or an adaptively determined incentive), the SRVPRVD process 307 is accessed to record the view event in the incentive history log for the incentive in database INCENT-DB 107. In particular, the incentive ID, an indicator of the displayed value, the expiration date, the URL (Web page) where viewed, the time, and, if a member ID is present (i.e., the incentive needed membership, for example because it was adaptively determined), the member ID are recorded. The indicator of the displayed value of the incentive in one implementation is the value of the incentive, and in another is the version number of the incentive or a pointer to the version of the incentive. The key here is to be able to recreate a historical record in the case that incentives change over time. More or fewer parameters of the incentive instance are recorded in the incentive history part of database INCENT-DB 107. Note that in alternate embodiments, this information may be stored in the member database (emphasis added).

As the Examiner will note, the above-noted language discloses using "a pointer to the version of the incentive" and not that the associating is made explicitly by pointers that are included in terms of the promotions. Nor has the Examiner explained how such disclosure can be interpreted to disclose that the associating is made explicitly by pointers that are included in terms of the promotions.

The Examiner also cites col. 42, lines 42-58 of MEYER as disclosing "determining whether the promotion that includes the qualifying value is active".

Applicants respectfully disagree. It is clear that the noted language of MEYER does not support the Examiner's assertion. Indeed, col. 42, lines 42-58 of MEYER merely states the following:

In the preferred embodiment, the code for process MRCHNT is provided in one or more formats adapted to a variety of popular Web servers running as merchant servers. Thus, the code for process MRCHNT may be supplied as Java servlets, as Perl CGI programs, C implementations targeted at the ISAPI (Internet Server API, Microsoft's plug-in standard application programmers interface (API) for adding capability to Internet Information Server (IIS), Microsoft's Web server), C implementations targeted at the NSAPI (Netscape's plug-in standard API for adding capability to Netscape's Web server), other C-based implementations, and as Microsoft COM objects suitable for use by server side scripting environments such as ASP (Active Server Pages, available with Microsoft's IIS). The service provider typically may also need to provide installation assistance, and the installation in some cases may require some simple additional custom coding (emphasis added).

As the Examiner will note, the above-noted language discloses using "standard application programmers interface (API) for adding capability to Internet Information Server"; not determining whether the promotion that includes the qualifying value is active. Nor has the Examiner explained how such disclosure can be interpreted to disclose determining whether the promotion that includes the qualifying value is active.

Thus, Applicants respectfully submit that independent claims 1, 2, 7, 11, 12 and 17 and dependent claims 3, 4, 6, 8-10, 13-23 are allowable.

Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Over Beach with Meyer and Simons

Claims 21-23 are also rejected under 35 U.S.C. §103(a) as being unpatentable over BEACH and MEYER and further in view of U.S. Patent No. 6,230,143 to SIMONS et al. ("SIMONS"). This rejection is respectfully traversed.

Applicants submit that the Examiner has failed to set forth a *prima facie* case of unpatentability under 35 U.S.C. § 103 because no proper combination of the above-noted documents discloses or suggests the combination of features recited in at least independent claims 2, 7 and 11.

Again, independent claims 2, 7 and 11 recite, *inter alia*,

checking a database of promotions for presence of a promotion that includes the qualifying value.

Furthermore, independent claim 2 recites, *inter alia*,

when a promotion that includes the qualifying value is present in the database, determining a reward value of the promotion that includes the qualifying value based on associating a module of selectively executable compiled web server code residing on a server's body of compiled code made explicitly by pointers that are included in terms of the promotion; and executing the module of selectively executable compiled code associated with the reward.

Additionally, independent claim 7 recites, *inter alia*,

when a promotion that includes the qualifying value is present in the database, determining whether the promotion that includes the qualifying value is active; and

when the promotion that includes the qualifying value is active, determining a reward value of the promotion that includes the qualifying value and executing a module of selectively executable compiled code associated with the reward value.

Also, independent claim 11 recites, *inter alia*,

when a promotion that includes the qualifying value is present in the database, executing a module of selectively executable compiled web server code that provides the promotion.

Applicants submit that no proper combination of BEACH, MEYER and SIMONS discloses or suggests, at least these features.

In addition to the above noted arguments presented above, Applicants submit that SIMONS fails to disclose or suggest checking a database of promotions for

presence of a promotion that includes the qualifying value. Applicants respectfully disagree. Indeed, the Examiner has not even alleged that SIMONS discloses this feature.

The Examiner instead asserts that SIMONS discloses or suggests the features of dependent claims 21-23, and in particular, using the recited database editor. The Examiner points to the Abstract of SIMONS in support of this assertion. Applicants respectfully traverse this rejection. The Abstract of SIMONS states the following:

A system and method for analyzing coupon redemption data, includes a parallel adaptive, self-arborizing network having a database component with a database containing consumer and client information, an extract module program that retrieves information from the database based on a set of user or computer designed criteria, an editor program which formats the information extracted from the database to be generated on a coupon or flyer to create a data template including at least one two dimensional bar code containing consumer and coupon information from the database, and a printing tool for encoding the data template on a coupon page. The system further includes a data recovery system, including at least one scanning device provided at the point of sale terminal adapted to read the two dimensional bar codes on the coupons and a store and forward system that stores the data collected by the scanning device at the point of sale terminal. The data redemption system includes a data accumulator that retrieves redeemed coupon information from the store and forward system in the retail client's store, which is transferred to a database analysis component of the parallel adaptive network via an Internet or similar modem communications transfer. The database analysis component of the parallel adaptive network analyzes the consumer and client information from the redeemed coupon data to determine consumer purchasing trends. The database analysis component learns from the analysis of consumer purchasing trends to define a modified set of coupon printing criteria based on the analysis (emphasis added).

As the Examiner will note, the above-noted language discloses using "an editor program which formats the information extracted from the database to be generated on a coupon or flyer to create a data template including at least one two dimensional bar code containing consumer and coupon information from the database". This language does not disclose or suggest adding, ending or changing of the promotion by interacting

with the database through a database editor. Nor has the Examiner explained how such disclosure can be interpreted to disclose adding, ending or changing of the promotion by interacting with the database through a database editor.

Thus, Applicants respectfully submit that independent claims 2, 7 and 11, and dependent claims 21-23 are allowable.

Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to **IBM Deposit Account No. 09-0457** (Endicott).

Respectfully submitted,
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